

## REMARKS

This amendment is in response to the Office Action dated on the 16<sup>th</sup> of August, 2005. Applicant amends claims 1, 3-7, 9-12, and 16-20, cancels claim 2 without disclaiming its subject matter, and adds new claims 21 through 32. No new matter has been added to new claims.

### Objection to Drawings

Drawings are amended in conformity with the Examiner's request. Replacement sheet of the drawing is submitted with this amendment.

FIG. 1 is amended by changing reference numeral 74 to 24.

FIG. 3 is amended by changing one reference numeral 50 to 52, and redirecting the other reference numeral 50 to designate a flashlight. Reference numeral 70 is changed to 71.

FIG. 4 is amended by changing reference numeral 74 to 24, and adding reference numerals 70 and 71 to designate a hatchet and a blade, respectively.

FIG. 7 is amended by adding reference numeral 21.

FIG. 8 is amended by redirecting reference numeral 95 to designate a locking hole.

FIG. 12 is amended by showing a knife 190 portion in the drawing.

FIG. 21 is amended by deleting reference numeral 330.

FIG. 26 is amended by adding reference numeral 473.

### Objection to Specification

Specification is amended in conformity with the Examiner's request.

### **Objection to Claims**

In claim 10, "claim 11" in the first line is changed to "claim 9".

In claim 12, "the" in the third line is changed to "to".

In claims 17 and 19, "withing" is deleted.

### **Status of Claims**

Claims 1 through 20 are pending. Claims 1, 6-10, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. (US Pub. No. US2004/0016058) in view of Spencer-Foote (US Patent 3,837,023). Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. and Spencer-Foote as applied to claim 1, and further in view of Mazzo (US Patent 5,103,520). Claims 3-5, 12, 14-15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. and Spencer-Foote as applied to claims 1 and 16, and further in view of Gibbs (US Patent 4,805,303). Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. in view of Spencer-Foote as applied to claim 1, and further in view of Herlbauer (US Patent 1,899,868).

### **Claim 1**

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. (US Pub. No. US 2004/0016058) in view of Spencer-Foote (US Patent 3,837,023). Applicant amends claim 1 to include a feature of "a digging tool rotatably mounted on the body of said hatchet, said digging tool attached to said housing, said digging tool overlaying said first one

of said compartments when said digging tool is in a closed position”, part of which is recited in the original claims 17 and 19.

In the rejection of claims 17 and 19, the examiner wrote that:

“Gardiner et al. in view of Spencer-Foote in further view of Gibbs teaches ... a digging tool *rotatably mounted* on the body of the hatchet about the pivot point, and *the digging tool overlaying the third compartment.*”

Regarding “a digging tool rotatably mounted on the body of said hatchet,” the examiner, however, wrote in the rejection of claim 2 that “Spencer-Foote . . . does not disclose the digging tool being rotatably mounted on the body of the hatchet.” Therefore, the Examiner’s assertion supporting the rejection of claims 17 and 19 is not consistent with the assertion supporting the rejection of claim 2. The examiner failed to clearly provide the rejection reasoning.

Under the Examiner’s reasoning for rejection of claims 2, 17 and 19, the combined references of Gardiner et al. ‘058, Spencer-Foote ‘023, and Mazzo ‘520 do not teach or suggest all the claim limitations.

Specifically, “said digging tool overlaying said first one of said compartments” is neither taught nor suggested by the references. In the rejection of claim 2, the examiner wrote “Mazzo teaches a multipurpose tool that has a digging tool 19 rotatably mounted on the body. It would have been obvious ... because modifying the mounting of the tool from internally to rotatably mounted provides quicker access to the digging tool.” However, the

fact that the tool is rotatably mounted cannot be translated into the digging tool overlaying the first one of the compartments, where the hatchet is being disposed in. In the rejection of claim 17, the examiner merely argued that the combined references teach “a digging tool rotatably mounted on the body of the hatchet . . . , and the digging tool overlaying the third one of said compartments”, but failed to specifically identify the reasons one of the ordinary skill in the art would have been motivated to select the cited references and combine them to modify the digging tool rotatably mounted on the body of the hatchet, and the *digging tool overlaying the third one of said compartments*.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The examiner failed to show that there is some suggestion or motivation to modify the reference, and therefore, the Examiner failed to establish a *prima facie* case. Withdrawal of the rejection is respectfully requested.

### **Rejection of Claim 3 under 35 U.S.C. 103(a)**

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. and Spencer-Foote as applied to claims 1 and 16, and further in view of Gibbs (US Patent 4,805,303). Applicant respectfully traverses the Examiner’s rejection as follows.

In support of the rejection, the Examiner wrote:

“Gibbs teaches a multi-tool device 10 further comprising a first locking button 48 and a second locking button 50, each being disposed at the first end of the housing, the first locking button locking said hatchet 14 in a closed position in the first compartment, and when pressed by a user, releases the hatchet to allow the user to rotate the hatchet and rotatably extract the cutting edge from the first compartment and the second locking button locking the hatchet in an open position (Figure 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to improve the hatchet with the teachings of Gibbs because locking the hatchet prevents the device from closing during use and preventing accidental cutting.”

The examiner failed to establish a prima facie case of obviousness because the prior art references do not teach or suggest all the claim limitations.

Claim 3 recites the feature of a first locking button and a second locking button to lock a hatchet in a closed position and an open position, respectively.

Gibbs ‘303 discloses two lock levers 48 and 50, but also discloses two blades 12 and 14, each of which is locked in its fully open position by engagement of each of the lock levers.<sup>1</sup> Lock lever 48 is used to lock the blade 12 in an open position, and lock lever 50 to lock the blade 14 in an open position.<sup>2</sup> Lock lever 48 and 50 are independently associated with two different blades 12 and 14, respectively.

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<sup>1</sup> Col. 4, lines 4-8 and lines 21-23 of Gibbs ‘303

<sup>2</sup> FIG. 4 of Gibbs ‘303

Gibbs '303 does not suggest any other lock lever other than the lever 48 or 50 to lock the blade in closed position. Gibbs '303 teaches that "the lock levers serve the function of the usual back springs provided in folding knives to act cooperatively with the blade tangs, ... ." <sup>3</sup> According to Gibbs '303, the same lock lever, which is used to lock the blade in an open position, is used to urge the blade in an closed position. In conclusion, Gibbs '303 suggests the use of a single lock lever both to lock a blade in an open position and to urge the blade in a closed position.

Therefore, the Examiner didn't show that the prior art references teach or suggest all the claim limitations. The withdrawal of the rejection is respectfully requested.

**Rejection of Claim 4 and 5 under 35 U.S.C. 103(a)**

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. (US Pub. No. US 2004/0016058) and Spencer-Foote (US Patent 3,837,023), and further in view of Gibbs (US Patent 4,805,303).

The Examiner wrote, in the rejection of claim 4:

"Spencer-Foote further teaches the multi-tool device comprising *a digging tool mounted* on the body of the hatchet and the digging tool being limited to a 90 degree rotation with respect to the body of the hatchet by the body of the hatchet (Figure 6)."; and

in the rejection of claim 5:

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<sup>3</sup> Col. 3, line 67 through col. 4, line 3 of Gibbs '303

“Spencer-Foote further teaches the multi-tool device comprising *a digging tool mounted* on the body of the hatchet and the digging tool being limited to a 90 degree rotation with respect to the body of the hatchet by the hammer head (Figure 6).”

The Examiner wrote for rejection of claim 2 that “Spencer-Foote . . . does not disclose the digging tool being rotatably mounted on the body of the hatchet”, and also wrote that “Mazzo teaches a multipurpose tool that has a digging tool 19 rotatably mounted on the body. It would have been obvious ... because modifying the mounting of the tool from internally to rotatably mounted provides quicker access to the digging tool.”

First, Spencer-Foote ‘023 doesn’t disclose the digging tool being rotatably mounted on the body of the hatchet, so there is no suggestion about restricting the rotation of the rotatably mounted digging tool.

Second, when Spencer-Foote ‘023 and Mazzo ‘520 are combined, nowhere do the combined references suggest how the rotation of the digging tool could be limited to 90 degrees. There is no specific suggestion in the combined references to modify the rotatably mounted digging tool to be limited to a 90 degree rotation *by the body of hatchet or by the hammer head*.

To establish a *prima facie* case under 35 U.S.C. 103(a), the Examiner “must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them.” *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999). The Examiner failed to identify specific reasons why one of ordinary skill

in the art would have been motivated to combine the cited references to prevent over-rotation of the digging tool by the body of hatchet or by the hammer head.

Therefore, withdrawal of the rejection of claims 4 and 5 is respectfully requested.

**Rejection of Claim 15 under 35 U.S.C. 103(a)**

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. (US Pub. No. US 2004/0016058) and Spencer-Foote (US Patent 3,837,023), and further in view of Gibbs (US Patent 4,805,303).

In support of the rejection, the Examiner wrote:

“Spencer-Foote further teaches the multi-tool device comprising a pulley (66 and 98) mounted on the hatchet, ... It would have been obvious to one of ordinary skill in the art at the time of invention to modify the location of the pulley ... .”

Spencer-Foote ‘023 teaches that 66 is a bore<sup>4</sup> and 98 is annular grooves<sup>5</sup>. Spencer-Foote ‘023 doesn’t disclose a pulley, and therefore, the cited prior art doesn’t suggest all the claim limitations. Withdrawal of the rejection is respectfully requested.

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<sup>4</sup> Fig. 6 and col. 4, lines 49-50 of Spencer-Foote ‘023

<sup>5</sup> Fig. 2 and col. 5, line 52 of Spencer-Foote ‘023



**Rejection of claim 16 under 35 U.S.C. 103(a)**

Claim 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. (US Pub. No. US 2004/0016058) in view of Spencer-Foote (US Patent 3,837,023).

In support of the rejection, the Examiner asserted that

“Gardiner et al. further teaches a multi-tool device comprising a single housing 12 and the housing comprising an elongated body having a plurality of compartments, at least one cutting tool removably mounted in a first compartment of the housing and a flashlight disposed in a second compartments of the housing.”

The Examiner failed to provide *prima facie* case, because Gardiner et al. ‘058 neither teaches nor suggests one cutting tool removably mounted in a first compartment of the housing. In the rejection of claim 1, the Examiner states that “Gardiner et al. teaches a multi-tool device comprising ... a plurality of tools 106 being *rotatably mounted in a first compartment* of the housing ... .” Again in the rejection of claim 16, the Examiner states that “Gardiner et al. further teaches a multi-tool device comprising ... at least one cutting tool *removably mounted in a first compartment* of the housing”. It is not clear which cutting tool the Examiner is pointing at in the rejection of claim 16.

Even if the cutting tool is interpreted as one of the plurality of the tools 106 rotatably mounted in a first compartment of the housing, Gardiner et al. ‘058 never suggests that the cutting tool is removably mounted. The plurality of tools 106 is included in a tool pod 16,

and the tool pod is affixed within spacer 28.<sup>6</sup> Gardiner et al. '058 discloses that "tool pod 16 ... includes a housing 98 having a planar floor 100 and two opposing upright walls 102 and 104, between which tools 106 are stowed."<sup>7</sup> According to Gardiner et al. '058, the tools are stowed in the housing 98, being able to pivot approximately 180 degrees from the stowed position<sup>8</sup>, and couldn't be removed from the housing. Nowhere does Gardiner et al. '058 disclose "at least one cutting tool removably mounted in a first one of said compartments of said housing."

The Examiner failed to show that there is suggestion or motivation to modify the reference, and therefore, failed to establish a *prima facie* case under 35 U.S.C. 103(a). Withdrawal of the rejection is respectfully requested.

**Rejection of claim 17 under 35 U.S.C. 103(a)**

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. (US Pub. No. US 2004/0016058) and Spencer-Foote (US Patent 3,837,023), and further in view of Gibbs (US Patent 4,805,303).

The rationale for the patentability of the above feature is discussed in claim 1. Withdrawal of the rejection is respectfully requested.

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<sup>6</sup> FIGS. 4-6 and 72<sup>nd</sup> paragraph of Gardiner et al. '058

<sup>7</sup> FIGS. 5-6 and 73<sup>rd</sup> paragraph of Gardiner et al. '058

<sup>8</sup> 72<sup>nd</sup> paragraph of Gardiner et al. '058

**Rejection of claim 18 under 35 U.S.C. 103(a)**

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. (US Pub. No. US 2004/0016058) and Spencer-Foote (US Patent 3,837,023), and further in view of Gibbs (US Patent 4,805,303). The rationale is discussed in the claim 3. Withdrawal of the rejection is respectfully requested.

**Rejection of claim 19 under 35 U.S.C. 103(a)**

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner et al. (US Pub. No. US 2004/0016058) and Spencer-Foote (US Patent 3,837,023), and further in view of Gibbs (US Patent 4,805,303). The rationale is discussed in the claim 1 and 16. Withdrawal of the rejection is respectfully requested.

**Rejection of Claims 6 through 14 under 35 U.S.C. 103(a)**

Claims 6 through 14 depend from claims 1, 3, 4, or 5. As stated above, claims 1, 3, 4 and 5 are patentable. Therefore, its dependent claims 6 through 14 are also patentable. Withdrawal of the rejection of claims 6 through 14 is respectfully requested.

**Rejection of Claims 20 under 35 U.S.C. 103(a)**

Applicant traverses the rejection of claim 19. Applicant believes the claim 19 is patentable over the cited prior arts. Withdrawal of the rejection of claim 20 is respectfully requested.

**Fee Incurred**

A fee of \$ 275.00 is incurred by the addition of 11 dependent claims in excess of 20 claims. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, it is submitted that all of the claims now present in the application are patentable over the cited references, taken either alone or combination and accordingly should now be in a conditions suitable for allowance.

No other issues remaining, reconsideration and favorable action upon all of the claims now present in the application is respectfully requested.

Respectfully submitted,



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